

RECEIVED
CENTRAL FAX CENTER
DEC 04 2006

REMARKS

Response to Claim Rejections Under 35 U.S.C. §102

Claims 1, and 40-51 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by Kieturakis (U.S. Pat. No. 5,794,626). The Examiner contends that the flex-blade tissue cutter described by Kieturakis are capable of being energized by RF energy. However, there is no description or suggestion in the cited reference of a tissue cutter capable of being energized with RF energy. To clarify the claims, applicants have required an electrical conductor with a distal end secured to the electrosurgical tissue cutter and a proximal end configured to be connected to an RF energy source. This amendment clear distinguishes the invention from the cited reference.

Claims 1, 40-49 and 51 were also rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by Patterson et al. (U.S. Pat. No. 5,941,869). The rejected claims require an electrosurgical tissue cutting member connected or connectable to an RF energy source to sever an intact tissue specimen from supporting tissue and to encapsulate the intact tissue specimen. Patterson et al. describes devices which sever tissue from supporting tissue and capture the severed tissue with a variety of capturing means. But the devices of Patterson do not encapsulate the severed tissue, they only capture the tissue.

Response to Claim Rejections Under 35 U.S.C. §103

Claims 29 and 31-32 were rejected by the Examiner under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Kieturakis (U.S. Pat. No. 5,794,626). In response, applicant has amended these claims to require the tissue cutting element to be energized by delivering RF energy thereto while rotating

the tissue cutter to cut tissue. Kieturakis fails to teach this feature and therefore cannot anticipate these claims. Moreover, the reference makes no suggestion that the cutting member may be an electrosurgical tissue cutting member which is energized with RF energy in order to cut tissue. Therefore the reference does not render obvious the invention of these claims.

Claim 33 was rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Kieturakis ('626) in view of Kanner et al. (U.S. Pat. No. 5,392,790). However, Kanner et al. fails to make up for the deficiencies of Kieturakis. Moreover, claim 33 calls for cutting tissue surrounding the instrument as the instrument is withdrawn. Kanner et al. fails to teach this feature. The combination does not teach all of the claimed features and provides no suggestion in this regard.

Conclusion

Applicants believe that the presently pending claims define patentable subject matter and respectfully request further consideration pursuant to the concurrently filed RCE.

Respectfully submitted,

By: 

Edward J. Lynch
Registration No. 24,422
Attorney for Applicants

DUANE MORRIS LLP
One Market
Spear Tower, Ste. 2000
San Francisco, CA 94105
Telephone: (415) 957-3000
Facsimile: (415) 957-3001
Direct Dial: (415) 957-3067